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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,495	10/25/2006	Alistair Oakes	42965-P110US	2282
43167	7590	03/20/2009		
WINSTEAD P.C. PO BOX 50784 DALLAS, TX 75201			EXAMINER BATTULA, PRADEEP CHOUDARY	
			ART UNIT 3725	PAPER NUMBER
			MAIL DATE 03/20/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,495	<b>Applicant(s)</b> OAKES, ALISTAIR	
	<b>Examiner</b> PRADEEP C. BATTULA	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 7, 2009 has been entered.

### ***Claim Objections***

Claim 24 is objected to because of the following informalities: The limitations of Claim 24 have been addressed in Claim 23 so it might be more appropriate to delete the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear to the examiner how the second identification can be on top of at least part of the first identification and then below it unless simultaneously both where in one portion it is above the first identification and in another portion below the first identification. Paragraph 0012 of the specification only lists above or below but not simultaneously both.

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2. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is only providing an indication that the second identification is printed in a non-simultaneous manner with the first identification, however, the term "substantially simultaneous" does not provide any kind of boundary since there is no standard for time. The specification indicates a .12 second in paragraph 0027. The "substantially simultaneous" limitation would give patentable weight to items beyond this time constraint which is not supported by the disclosure.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for printing in a particular range of time, does not reasonably provide enablement for a extremely large range. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Paragraph 0027 requires that it be approximately .12 seconds which is a specific value but the claims leave it open for an indefinite range of time.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 3, 5, 6, 8 – 15, 18, 20 rejected under 35 U.S.C. 102(b) as being anticipated by Behm et al. (Behm; U.S. 5,667,250).

In regards to Claim 1, Behm, an identification means 10 (Column 3, Lines 4 - 5; Figure 1, Item 10), said identification means including a first identification portion 20, 22, 24 relating to data of a secure or confidential nature in the form of one or more images, characters and/or text (Column 3, Lines 13 – 15; Figure 1, Items 20, 22, 24; shows that images and characters are used and that it is game indicia and of seal coat 22 and release layer 24; Column 4, Lines 61 – 63 teaches of overprinting of the seal coat and release layer in a different embodiment but Column 5, Lines 4 – 12 teaches of the differences between the embodiments and the overprinting is not taught as a difference therefore the identification can be considered 20, 22, 24 since they are all printings), a second identification 34 portion (Column 3, Lines 40 – 46; Column 4, Lines 21 – 24; Figure 2) removably located directly on top of at least a part of said first identification portion to at least partially mask the first identification portion (Column 3, Lines 27 – 35, 46 – 49 teaches the confusion pattern only does not interfere with play indicia when scratched off) until said second identification portion has been removed therefrom (Column 3, Lines 46 – 49), said second identification portion also being in the form of one or more images, characters and/or text (Column 2, Lines 63 – 64; Figure 2), and wherein the second identification portion is provided in overlapping relationship on said first identification portion (Figure 1, Items 20, 34) so that the combination of the first and second identification portions forms a further one or more images, characters and/or

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text different in appearance to said first and second identification portions, the first and second identification portions being undecipherable from the further one or more images, characters and/or text until the second identification portion has been removed (Column 3, Lines 46 – 49 teaches that the pattern 34 only does not interfere when scratched off so when trying to view indicia 20 without removing 34 even more indicia will be seen with the combination of indicia 34 and 20; furthermore, the combination of indicia creates a third indicia which is more confusing), and wherein at least one further removable portion or coating 26, 28 (Column 3, Lines 18 - 24, 30 – 31 teaches of the removable coating 26 and an overprint 28 placed on top) is applied over at least a part of said first and second overlapping identification portions (Figure 1, Items 20, 34, 26, 28) wherein said first and second identification portions are unique in form, wherein text, characters and/or images of said first identification portion are misaligned relative to those of said second identification portion to create a further image (Figure 2 shows that the confusion pattern is misaligned itself so the indicia 20 would also be misaligned), character and/or text which is different in appearance to said first and second identification portions (The combination of indicia creates a third indicia which is more confusing).

In regards to Claim 2, Behm further discloses wherein the second identification portion is formed from an abradable material which is irreversibly removable from the first identification portion (Column 3, Lines 30 – 31 teaches that the printing itself is removable and therefore abradable considering it is also on a game card).

In regards to Claim 3, Behm further discloses wherein the second identification portion is located with a whole or substantial part of said first identification portion (Figure 1, Items 34, 20 show that 34 is smaller than 20 however 34 is covering a substantial part of 20).

In regards to Claim 5, Behm further discloses wherein the second identification portion is provided on top of or above the first identification portion (Figure 1, Items 20, 22, 24, 34).

In regards to Claim 6, Behm further discloses wherein the second identification portion is different in appearance to the first identification portion (Figure 1, Item 20; Figure 2).

In regards to Claim 8, Behm further discloses wherein the at least one further removable portion or coating is applied to a whole of substantial part of said first and second identification portions (Figure 1, Items 26, 28 show that they cover a whole of first and second identification portions as seen with Items 20, 34).

In regards to Claim 9, Behm further discloses wherein the further removable portion includes one or more layers of abradable material (Column 3, Lines 43 – 46 teaches that 26 is scratched off and 28 is just an overprint on 26 so that will also abrade).

In regards to Claim 10, Behm further discloses wherein at least a third identification portion 30A is provided on the further removable portion (Column 3, Lines 21 – 24; Figure 1, Items 30).

In regards to Claim 11, Behm further discloses wherein the third identification portion is visible to a user viewing the identification means (Column 3, Lines 21 – 24 teach that it is game play indicators and is the top layer; Figure 1, Item 30A).

In regards to Claim 12, Behm further discloses wherein the third identification portion relates to or is associated with one or more images, characters and/or text provided on the identification means (Column 3, Lines 21 – 24 teach that 30 is game play indicator and it is known that 20 is game play indicia; Figure 1, Items 30A, 20).

In regards to Claim 13, Behm further discloses wherein the one or more images, characters and/or text are separate to and/or independent of said first and/or second identification portions (Figure 1, Items 34, 30, 20 show that they are separate from one another).

In regards to Claim 14, Behm further discloses wherein the third identification portion is formed from abradable material (Column 3, Lines 43 - 46 teaches that 26 is scratched off the game piece).

In regards to Claim 15, Behm further discloses wherein the identification means are any of a carrier, telephone card, promotional game, ticket, pin card, label, scratch card, brand protection process or lottery ticket (Column 3, Lines 3 – 6; Figure 1).

In regards to Claim 18, Behm further discloses wherein the first identification portion is printed onto the identification means (Column 3, Lines 13 – 15; Column 4, Lines 61 – 63 teaches of overprinting of the seal coat and release layer in a different embodiment but Column 5, Lines 4 – 12 teaches of the differences between the embodiments and the overprinting is not taught as a difference therefore the



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identification can be considered 20, 22, 24 since they are all printings; All the portions in the card are considered to be a portion of the identification means).

In regards to Claim 20, Behm further discloses wherein the first identification portion includes a resin containing material (Column 3, Lines 13 – 15 teach of printing the first identification which is inherently done with ink; inks are well known to have resins).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behm in view of Raymond.

In regards to Claims 16 and 17, Behm does not disclose wherein the identification means is provided with attachment means for attaching the same to an article wherein the attachment means includes an adhesive provided thereon.

Raymond teaches of an identification means having a first identification covered by a second identification which is of an abradable material 5 (Page 5, Lines 33 – 38; Figure 3, Item 5) wherein the identification means has a rebondable adhesive (Page 2, Lines 32 – 38 → Page 3, Lines 1 – 16). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the

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identification means of Behm with an adhesive on one side of the ticket in order to allow for the ticket to be applied to different objects and prevent loss (Page 3, Lines 4 – 14).

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behm in view of Itakura.

In regards to Claim 21, Behm further discloses that the second identification is a removable ink having a resin (Column 3, Lines 29 – 31 teaches of the pattern being removable which is printed on the release coating 24; Column 4, Lines 4 – 10 teach that it is an ink with resin).

Behm does not disclose wherein the second identification portion includes resin and wax.

Itakura teaches that it is very well known in the art that concealing layers, for concealing printed matter, can be comprised of rupturable layers comprised of resins and waxes (Paragraph 0005). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the concealing layer of Behm with such materials in order to provide a known alternative which provides the same result.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behm in view of Griffin.

In regards to Claim 22, Behm discloses that the removable portion is just a removable coating (Column 3, Lines 18 – 20).

Behm does not disclose wherein the further removable portion includes a wax containing material.

Griffin teaches of providing a scratch off coating 60 which is of a thin pigmented paraffin or other kind of wax. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the removable coating of Griffin for the removable portion of Behm in order to provide a known alternative which provides the same result.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behm in view of Weber et al. (Weber; U.S. 5,470,662).

Behm does not disclose wherein a holographic image is provided on said identification means.

Weber discloses that reflection holograms are well suited in constructions such as lottery tickets (Column 9, Lines 59 - 65). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the game piece of Behm with a reflection hologram in order to provide a security for the game piece (Column 9, Lines 59 – 61).

9. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behm.

In regards to Claims 23 and 24, please review the rejection of Claim 1 for the structural elements required. Behm does not explicitly disclose wherein the first and second identification portions are applied to the identification means substantially simultaneously during manufacture, however, the term is indefinite (as previously discussed) but Behm further discloses wherein said first and second identification portions are randomly computer generated (Column 4, Lines 21 – 26 teaches that the

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second identification is random and considering it is a lottery ticket the order of or symbols used in the ticket for the first identification would also be random; Furthermore considering the printing processes and indicia there is an inherent use of a computer). The Examiner takes Official Notice that it is well known in the graphic arts to produce two printed patterns of different material in very close intervals. It would have been obvious to do so in Behm in order to prevent any kind of early detection or revealing of the information to be concealed. [Furthermore, considering time is relative if a process takes 1 minute and all the printing is only done 10 seconds it is still substantially simultaneous, however, Applicant's disclosure does not support this kind of printing limitation].

### ***Response to Arguments***

Applicant's arguments filed January 7, 2009 have been fully considered but they are not persuasive. Time is relative and as the examples discussed above the limitation of substantially simultaneous is not a proper limitation with respect to the specification.

Furthermore, the method claim 23 was not originally restricted as it was only a method which provided the structure that had already been discussed and only added an indefinite step of production. Due to the interview the method of the generation of was allowed to be added, however any further additions to the method of manufacturing will be susceptible to consideration of Election by Original Presentation due to the methods requiring a new search in a new field for a new invention.

With respect to the Patent Search, the Examiner cannot comment on this as Applicant has not discussed the content of the disclosures of these Patents.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./  
Examiner, Art Unit 3725  
March 18, 2009

/Dana Ross/  
Supervisory Patent Examiner, Art Unit 3725